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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,642	04/02/2004	Cameron Kerrigan	50623.00380	2856
7590	09/15/2004			EXAMINER
Squire, Sanders & Dempsey L.L.P. Suite 300 1 Maritime Plaza San Francisco, CA 94111			EDWARDS, LAURA ESTELLE	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 09/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

M12

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/817,642	KERRIGAN, CAMERON
	<b>Examiner</b>	<b>Art Unit</b>
	Laura Edwards	1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date ____.	6) <input type="checkbox"/> Other: ____.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 1, Applicant recites in lines 4-5, “a processing system to modify the coating substance applied to the stent supported by the support fixture” and the specification as originally filed does not teach or suggest such a general processing system.

With respect to claim 3, the specification as originally filed does not teach or suggest a “pressure system to apply a pressure to the support fixture”. As presently claimed, the pressure can be positive and the specification as originally filed only suggests that a vacuum pressure can be supplied.

With respect to claim 7, the specification as originally filed fails to teach or suggest, “the coupler allows the support fixture to be rotated without the conduit being rotated”. This negative limitation is not suggested or implied anywhere in the specification.

With respect to claims 8 and 9, see the response above to claim 3 with respect to the claiming of a general processing system and wherein said system is a pressure system.

For reasons mentioned above and the fact that none of the above limitations are explicitly or implicitly disclosed in the specification as originally filed, the limitations of claims 1 and 7-9 constitute new matter.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4-11, 13, and 14 of copending Application No. 10/254203. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present application and the '203 application claim a single inventive concept to an apparatus for supporting a stent during application of a coating substance comprising a support fixture or mandrel, a vacuum device for applying a vacuum to the support fixture, and a coupling element coupling the support fixture and the vacuum pressure system. While the claims of the present application are broader than those in the '203 application, the inventive concept remains the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 4, 5, and 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Leidner et al (US 6,056,993).

Leidner et al teach a stent coating system comprising a support fixture or mandrel (12) to support the stent during the application of a coating substance; a processing system (rotary-14 or electrostatic charging-30) to modify the coating substance applied to the stent supported by the support fixture; and a coupling element (24) configured to connect one side of the support fixture to the processing system to allow the support fixture to be rotated with respect to the processing system.

With respect to claim 2, the right side of the mandrel is capable of being connected to a rotational output motor (14) and the left side of the mandrel is capable of being connected to electrostatic charging means.

With respect to claim 4, a conduit (not numbered) as shown in Fig. 1 connects the coupling element 24 and motor (14).

With respect to claim 5, the mandrel defines a component on which the stent is directly placed in contact therewith.

With respect to claim 7, see coupler (30, 68), a support fixture (12) connected to a upper facing side of the coupler, to support a stent during the application of a coating substance to the stent, and a conduit or wire (72) connected to another side of the coupler, wherein the coupler allows the support fixture to be rotated via rotational motor (14) without the conduit being rotated.

With respect to claim 8, the conduit or wire (72) is connected to a power source (62).

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Narayanan et al (US 6,723,373).

Narayanan et al teach a stent coating system comprising a support fixture or mandrel (10) to support the stent during the application of a coating substance; a processing system (right rotary-20 or left translational-carriage motor) to modify the coating substance applied to the stent supported by the support fixture; and a coupling element (mandrel support) configured to connect one side of the support fixture to the processing system to allow the support fixture to be rotated with respect to the processing system.

With respect to claim 2, see support fixture connected to motor (20).

With respect to claim 4, a conduit (not numbered) as shown in Fig. 22 is disposed between the mandrel chuck and the motor (20).

With respect to claim 5, the mandrel defines a component on which the stent is directly placed in contact therewith.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Pacetti (US 6,743,462).

Pacetti teaches a stent coating system comprising a support fixture or mandrel (18) to support the stent during the application of a coating substance; a processing system (rotary-20B) to modify the coating substance applied to the stent supported by the support fixture; and a coupling element (204) configured to connect one side of the support fixture to the processing system to allow the support fixture to be rotated with respect to the processing system.

With respect to claim 3, the coating system is placed within a vacuum chamber or pressure system (10).

With respect to claim 4, see conduit (not numbered) between coupling element (204) and processing system (20R).

With respect to claim 4, the mandrel defines a component on which the stent is directly placed in contact therewith.

With respect to claim 5, the mandrel includes flared end components at opposite ends of the mandrel that hold the stent in place and the flared end components do not contact the interior of the stent.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pacetti (US 6,743,462).

Pacetti teaches a stent coating system comprising a coupler (204), a support fixture or mandrel (18) to support the stent during the application of a coating substance; and a conduit (not numbered) between a rotary motor (20B) and the coupling element (204) as shown in Fig. 1. Pacetti does not explicitly teach that the conduit connecting the motor (20B) and rotating coupling element (204) does not rotate. However, one of ordinary skill in the art would expect from the depiction in Fig. 1 of the rotation arrow being about an end portion of the coupling element (204) and NOT the conduit connected to the motor (20B) that the conduit does not rotate. Regardless, it is within the purview of one skilled in the art to provide a rotating coupling element relative to a fixed conduit to provide for rotation of the stent during coating.

With respect to claim 9, the conduit is connected within pressure chamber (10).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Laura Edwards  
Primary Examiner  
Art Unit 1734

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September 13, 2004